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Supreme Court of the United States

OCTOBER TERM, 1963

No. [redacted] 121

RADIATOR SPECIALTY COMPANY, *Petitioner,*

vs.

RICHARD MICEK, *Respondent.*

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

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RADIATOR SPECIALTY COMPANY, *Petitioner,*

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RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

Respondent prays that this Court deny the Petition for a Writ of Certiorari.

THE OPINIONS BELOW

The opinion of the Court of Appeals for the Ninth Circuit is reported at 327 F. 2d 554 and 140 USPQ 294. The opinion of the District Court (S.D. Calif.) is reported at 135 USPQ 220. These opinions appear at App.* 2a, 14a.

*Appendix to the Petition

JURISDICTION

Jurisdiction is requested by Petitioner under 28 U.S.C. §1254(1).

Petitioner alleges no "special and important" reasons for this Court to grant certiorari, no question of public importance, nor any conflicting decisions of two Circuits, but merely that the decision on patent validity is believed in conflict with the decision of this Court in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147 (1950). Aside from the affirmed judgment of misuse of confidential information and the award of attorney's fees throughout the proceedings, each now final because Petitioner does not seek review thereof, this is an ordinary patent case, involving only one patent which is not likely to become involved in further litigation. *Rice v. Sioux City Cemetery*, 349 U.S. 70, 74 (1955). The unreported prior suit in Colorado, which Petitioner chose not to defend and which resulted in a consent judgment, was against two distributors of Petitioner's device. *All others in the industry, except Petitioner, have respected the patent.* The decision in this suit is thus of interest only to the litigants. *Lane & Bowler Corp. v. Western Well Works*, 261 U. S. 387, 393 (1923). Apparently having presented, both in the District Court and the Circuit Court of Appeals, its best arguments, its best defenses, and its best theories, and lost, Petitioner now seeks a third round to expound them again.

There is no merit to Petitioner's assertion that the judgment on the issue of validity was unduly influenced by the issue of misuse of confidential information. As shown by its opinion, the Court of Appeals, as did the

District Court, decided the question of patent validity and infringement *before* deciding the issues of misuse of confidential information and award of attorney's fees. Significantly, the latter is not mentioned by Petitioner as allegedly influencing the decision on the issue of validity.

THE ALLEGED QUESTION PRESENTED

The alleged question presented by Petitioner is confused, contains irrelevant matter, and contains obvious misstatements or is misleading. The alleged question is not clear as to whether the issue to be decided is validity of the patent, the influence of the misuse of confidential information decision on the issue of validity, or whether the Court below should have gone into somewhat greater detail in its decision on the issue of validity. Reference to considering "asserted infringement by the copier" is irrelevant, because nowhere does Petitioner assert that the Court below was in error in holding Petitioner guilty of infringement of the patent. As pointed out above, the Court below did not *first* decide the question of misuse of confidential information, as indicated in the question, but *first* decided the issues of validity and infringement. The alleged question also indicates that the combination of the patent is the *same* combination as that conceded in the Patent Office, which is not true. If Petitioner did not intend that meaning, then the question is clearly misleading. The alleged question presented is not such a question this Court should undertake to answer.

CONSTITUTIONAL PROVISION AND STATUTES INVOLVED

The Constitutional provision, Art. I §8, and the pertinent portions of the Statutes involved, 35 U.S.C.

§101, 35 U.S.C. §102(g), 35 U.S.C. §103 and 35 U.S.C. §282, are set forth in the Petition.

STATEMENT OF THE CASE

The statement of the case by Petitioner is essentially correct. However, it should be noted that the devices with which Respondent was ascertaining market acceptance were merely samples and that Respondent was not in a position to fill any orders, until after Petitioner had entered the picture.

ARGUMENT

The presumption of validity of a patent is now statutory.

Petitioner asserts that this Court last restated the presumption of validity in 1934, in *Radio Corp. v. Radio Laboratories*, 293 U.S. 1, 8 (1934), and that there should be no presumption of validity of a patent for a combination of old elements, in view of *Great Atlantic and Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147 (1950). However, subsequent to 1950, *the Congress has spoken*, by adoption of the *Act of July 19, 1952*, c. 950 §1, 66 Stat. 812, namely 35 U.S.C. §282. The Reviser's notes indicate that §282 was derived from 35 U.S.C., 1946 ed. §69. The latter contained no provision similar to the first paragraph of §282, which reads as follows:

> "A patent shall be presumed to be valid. The burden of establishing the invalidity of a patent shall rest on a party asserting it."

There are no exceptions in the Statute to the presumption of validity of a patent.

The Court of Appeals for the Ninth Circuit Is Cognizant of the Decision of This Court in The A & P Case.

The Petitioner would have this Court believe that the Court below is not cognizant of the decision of this Court in *Great Atl. & Pac. Tea Co. v. Supermarket Equip. Corp.*, supra, often referred to as "the A & P case," but the decisions of that Court indicate a clear cognizance thereof. The appeal hearing in the present suit was held on February 11, 1963, before Judges Chambers, Stephens and Jertberg, while on May 17, 1963, in *Farr Co. v. American Air Filter Company, Inc.*, 318 F. 2d 500, 137 USPQ 627, cert. den. 375 U.S. 904, Judges Stephens, Jertberg and Koelsch reversed the District Court, holding the patent there involved invalid on the basis of the A & P case. On July 16, 1963, in *Twentier's Research, Inc. v. Hollister, Inc.*, 319 F. 2d 898, 138 USPQ 473, Judge Jertberg wrote the opinion in a decision affirming the holding of validity of the patent involved, citing and quoting extensively from the A & P case.

The conclusion is inescapable that, at the time the decision was handed down in the instant suit, namely, January 15, 1964, the Court of Appeals for the Ninth Circuit was not only cognizant of the A & P case, but was fairly well saturated with it.

The Court of Appeals correctly applied the statutory test of invention.

The admirably succinct portion of the opinion of the Court of Appeals relating to the issue of validity (App. 4a) is as follows:

> "We have traced through all of the prior art patents placed in evidence by the parties and we do not find Micek's patent anticipated by any of them. The presumption of validity, to us, remains unim-

> paired. Broken up into little parts, there is nothing new about any feature. But it is the combination of many old elements that has created something new (for the moment at least) beyond the ordinary mechanic's skill."

In holding that the patent in suit exhibited "something new—beyond the ordinary mechanic's skill," the Court below correctly applied the test of invention of the statute, 35 U.S.C. §103, supra, i.e. that the differences over the prior art were not "obvious . . . to a person having ordinary skill in the art." This provision is based upon the Act of July 19, 1952, c. 950, §1, 66 Stat. 798, adopted subsequent to the A & P case (1950). As stated on May 14, 1964, by the Sixth Circuit in *Monroe Auto Equipment Co. v. Heckethorn Co.*, ___ F. 2d ___, 141 USPQ 549, 553 (advance sheet):

> "From this it may be said that invention is synonymous with unobviousness."

Of course, the test set forth in the A & P case with respect to a "conjunction or concert of known elements," i.e. "only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable" (340 U.S. at 152), is consistent with the present statute, since it appears axiomatic that a combination of old elements *not obvious* to those skilled in the art would meet such a test.

Additional reasons why the patent in suit is valid.

The failure of the prior art — and particularly the Detjen patent (Dft's Ex. C-12) to which, in the Patent Office, Respondent conceded the claim on which Petitioner now places such emphasis—to teach or suggest either the stop means for the yoke trunnions which limit the yoke against lateral play, or the diverging offsets

of the yoke which engage the stand pipe to limit the upward throw of the ball. These are actually new elements of the combination, although treated by the Court below as parts of old elements.

The representation to the Patent Office of the Petitioner itself, in attempting to secure *its own patent* (Pls. Ex. 61, p. 15) that ". . . the inwardly angled pivot arm portions of the yoke member . . . prevent lateral shifting and misalignment of the valve ball" and therefore involve invention.

The long period of experimentation undergone by Respondent, before developing the device of the patent in suit.

The description of the copied device by Petitioner itself, before litigation began, such as "A revolutionary new idea"; "The amazing new flush control unit"; "Because of the very principle of its operation—it cannot fail to work quickly every time."

The numerous devices submitted to Petitioner by others, prior to or at about the same time as Respondent's device, but considered by Petitioner and discarded, none of which teach or suggest the invention of the patent in suit.

The prior patents, relied on below by Petitioner as suggesting the yoke of the patent in suit, i.e. Bispham (Def. Ex. C-2) and Vote (Def. Ex. C-9), lie in non-analogous art and therefore cannot suggest the same. *Stearns v. Tinker & Rasor*, 220 F. 2d 49, 56, cert. den. 350 U.S. 830 (9 Cir. 1956); *Allied Wheel Products v. Rude*, 206 F. 2d 752, 755 (6 Cir. 1953); *Radiator Specialty Co. v. Buhot*, 39 F. 2d 373, 375 (3.Cir. 1930).

The conjunction of elements of the claims of the patent in suit cooperate to produce a result which exceeds the sum of the parts. *Grt. Atl. & Pac. Tea Co. v. Supermarket Equip. Corp.*, supra; *Twentier's Research, Inc. v. Hollister, Inc.*, supra.

CONCLUSION

We do not believe that this Court would wish that we fully argue in this brief the merits of the patent in suit over all of the prior art cited and discussed in the trial court.

We have attempted to show that what is involved here is merely the issue of validity. The applicable statutes were applied and, on its merits, the patent found valid over art which is clearly distinguishable.

Since the petitioner has lost, it seeks to create something special which would warrant judicial review by this Court. In grasping for the special and important reasons which would raise this case from the status of an ordinary patent case, Petitioner has muddled together a complex question which is confused, inaccurate and contains irrelevant matter. Upon careful scrutiny, this question fails to define any clear cut issue which warrants this Court's review.

Respectfully submitted,

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